

REMARKS

As of the filing of the present reply, claims 1-19 were pending in the above-identified US Patent Application.

In the Office Action, the Examiner maintained an obviousness-type double patenting rejection of claims 1-19 over claims 1-20 of U.S. Patent No. 7,244,467 to Grossman et al., maintained a rejection of claims 1, 2, and 4-19 under 35 USC §103 as being unpatentable over Applicants' admitted prior art (AAPA) in view of Japanese patent JP 01-180959 A to Nakamura et al. (Nakamura) and U.S. Patent No. 6,153,313 to Rigney et al. (Rigney), and maintained a rejection of claim 3 under 35 USC §103 as unpatentable over the AAPA, Nakamura, and Rigney in further view of U.S. Patent No. to 6,375,425 to Lee et al. (Lee). Favorable reconsideration and allowance of claims 1-19 are respectfully requested in view of the following remarks.

Double Patenting Rejections

The Examiner explained that the double patenting rejection based on Grossman et al. was not overcome because Applicants' Terminal Disclaimer filed May 28, 2008, was not accepted. The explanation was that

The disclaimer fee in accordance with 37 CFR 1.20(d) has not been submitted, nor is there an authorization in the application file to charge a specified Deposit Account or credit card.

Applicants respectfully disagree. The USPTO documents attached to this reply prove that the fee was submitted, accepted and deducted from the undersigned's Deposit Account on May 28, 2008.

Accordingly, Applicants again respectfully request withdrawal of the obviousness-type double patenting rejection.

Rejections under 35 USC §103

As noted above, the §103 rejections are based on the combination of the AAPA, Nakamura and Rigney alone or in further view of Lee.

In the "Response to Arguments" section of the Office Action, the Examiner explained that Applicants' arguments in the reply filed May 28, 2008, was unpersuasive because

(1) Applicants' "overlay coating is in fact a diffusion coating, where the applicant's specification clearly discloses that an overlay coating has a diffusion zone (see applicant's specification at paragraph 0005)," and

(2) “the Nakamura reference discloses that the treatment method enhances the resistance to thermal fatigue of the surface of a coating layer obtained by known coating treatments....”

Applicants respectfully request reconsideration.

The Examiner argues that an overlay coating is a diffusion coating because it shares certain characteristics of a diffusion coating, namely, a diffusion zone. However, the Examiner is certainly aware that the patent literature (of record and otherwise) contains numerous references to overlay coatings and diffusion coatings as two different types of coatings that are readily distinguishable in terms of microstructure, chemistry, properties, and how they are deposited. The art has adopted the names “overlay coating” and “diffusion coating” even though overlay coatings contain a diffusion zone and diffusion coatings have an overlay (additive) portion. Therefore, to argue that “the overlay coating is in fact a diffusion coating” is untenable, if not for the above reasons, then for the reason that these coatings are defined in paragraph [0005] of Applicants’ specification. MPEP §2173.01.

Finally, the argument that one would be motivated to modify the AAPA on the grounds that “the Nakamura reference discloses that the

treatment method enhances the resistance to thermal fatigue of the surface of a coating layer” overlooks the fact that “NiAl overlay bond coats [have] higher creep resistance and flow or yield strengths at elevated temperatures” than diffusion aluminide bond coats. Paragraph [0009]. See also [0024], including Applicants’ teaching that:

While various properties of coating, including microhardness, strength and plasticity, are known to be effected by microstructure, it is believed that the influence that microstructure might have on oxidation, which leads to TBC spallation, has not.

Because the yield strength of NiAl overlay coatings do not need to be improved, one skilled in the art would not look to Nakamura because Nakamura’s teachings are specific to improving “the resistance to thermal fatigue of the surface of a coating layer.” (See the three paragraphs on page 5 of the translation, and the section titled “Effect of the Invention” on page 12 of the translation.) Nakamura admittedly discusses corrosion resistance, but only to the extent that the disclosed treatment “obtain[s] a coating layer with good resistance to thermal fatigue without a loss in resistance to corrosion.” (Paragraph bridging pages 7 and 8 of the translation; emphasis added.) Therefore, Nakamura provides absolutely no suggestion that oxidation

resistance could be improved by recrystallization.

In view of the above remarks, Applicants believe that the combination of the AAPA and Nakamura, alone or in combination with Rigney and/or Lee, does not teach or suggest Applicants' claimed invention, and Applicants respectfully request withdrawal of the §103 rejections.

Closing

Should the Examiner have any questions with respect to any matter now of record, Applicants' representative may be reached at (219) 462-4999.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Domenica N.S. Hartman".

Domenica N.S. Hartman
Reg. No. 32,701

January 12, 2009
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Attachments: Copy of Electronic Acknowledgment Receipt; Copy of Terminal Disclaimer filed 5/28/08; Copy of Electronic Patent Application Fee Transmittal; Copy of Deposit Account Statement for May 2008

Electronic Acknowledgement Receipt

EFS ID:	3364359
Application Number:	10711584
International Application Number:	
Confirmation Number:	5583
Title of Invention:	BETA-PHASE NICKEL ALUMINIDE OVERLAY COATING AND PROCESS THEREFOR
First Named Inventor/Applicant Name:	Irene Spitsberg
Customer Number:	30952
Filer:	Domenica N. S. Hartman/Gayle Pietro
Filer Authorized By:	Domenica N. S. Hartman
Attorney Docket Number:	121492-3
Receipt Date:	28-MAY-2008
Filing Date:	27-SEP-2004
Time Stamp:	09:44:20
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	yes
Payment Type	Deposit Account
Payment was successfully received in RAM	\$ 130
RAM confirmation Number	15874
Deposit Account	080960
Authorized User	

The Director of the USPTO is hereby authorized to charge indicated fees and credit any overpayment as follows:

Charge any Additional Fees required under 37 C.F.R. Section 1.21 (Miscellaneous fees and charges)

File Listing:

Document Number	Document Description	File Name	File Size(Bytes) /Message Digest	Multi Part /.zip	Pages (if appl.)
1	Amendment - After Non-Final Rejection	A4-1828_Am_A.pdf	85042	no	16
			ee785715dda70e8c8dbe331ad237cfaa2c64021		

Warnings:**Information:**

2	Terminal Disclaimer Filed	121492-3-Terminal-Disclaimer.pdf	79886	no	1
			f90adf8a9ee306a414755c16b1eec945a8f61b3b		

Warnings:**Information:**

3	Fee Worksheet (PTO-06)	fee-info.pdf	8203	no	2
			3d304244d5906910e91eaa8b59f81860e53f47b7		

Warnings:**Information:**

Total Files Size (in bytes):			173131
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New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

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**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING
REJECTION OVER A "PRIOR" PATENT**Docket Number (Optional)
121492-3

In re Application of: Irene Spitsberg et al.

Application No.: 10/711,584

Filed: September 27, 2004

For: BETA-PHASE NICKEL ALUMINIDE OVERLAY COATING AND PROCESS THEREFOR

The owner*, General Electric Company, of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term **prior patent** No. 7,244,467 as the term of said prior patent is defined in 35 U.S.C. 154 and 173, and as the term of said **prior patent** is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the **prior patent** are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of the **prior patent**, "as the term of said **prior patent** is presently shortened by any terminal disclaimer," in the event that said **prior patent** later:

- expires for failure to pay a maintenance fee;
- is held unenforceable;
- is found invalid by a court of competent jurisdiction;
- is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321;
- has all claims canceled by a reexamination certificate;
- is reissued; or
- is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney or agent of record. Reg. No. 32,721

/Domenica N.S. Hartman/

Signature

May 27, 2008

Date

Domenica N.S. Hartman

Typed or printed name

(219) 462-4999

Telephone Number

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) included.

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*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).
Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Electronic Patent Application Fee Transmittal

Application Number:	10711584			
Filing Date:	27-Sep-2004			
Title of Invention:	BETA-PHASE NICKEL ALUMINIDE OVERLAY COATING AND PROCESS THEREFOR			
First Named Inventor/Applicant Name:	Irene Spitsberg			
Filer:	Domenica N. S. Hartman/Gayle Pietro			
Attorney Docket Number:	121492-3			
Filed as Large Entity				
Utility Filing Fees				
Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Basic Filing:				
Pages:				
Claims:				
Miscellaneous-Filing:				
Petition:				
Petition fee- 37 CFR 1.17(h) (Group III)	1464	1	130	130
Patent-Appeals-and-Interference:				
Post-Allowance-and-Post-Issuance:				
Extension-of-Time:				

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Miscellaneous:				
Total in USD (\$)				130



**United States
Patent and
Trademark Office**



Deposit Account Statement

Requested Statement Month: May 2008
 Deposit Account Number: 080960
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DATE	SEQ	POSTING REF TXT	ATTORNEY DOCKET NBR	FEE CODE	AMT	BAL
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05/29	10547	10906886	A4-1869	2251	\$60.00	\$1,195.54

START	SUM OF	SUM OF	END
BALANCE	CHARGES	REPLENISH	BALANCE
\$2,078.54	\$10,219.00	\$9,336.00	\$1,195.54

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